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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/267,025	03/11/99	SHIELDS	R TF-2018-03-R

THOMAS C FEIX  
241 NORTH SAN MATEO DRIVE  
SAN MATEO CA 94401

IM71/0922

EXAMINER
WATKINS III, W

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 09/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/267,025

Applicant(s)

Shields

Examiner

W. Watkins

Group Art Unit

1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on prelim & specified 3-11-99.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-21 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-21 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3-11-99 15hert
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1772

#### DETAILED ACTION

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Page 6, and the two pages referenced on page 6, of the original unsigned declaration filed on March 11, 1999, that describe the error, are absent in the declaration signed by Mr. Ross and submitted with the Rule 147 petition.

2. Claims 1-21 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Art Unit: 1772

4. Applicant is requested to supply a PTO Form 1449 listing the references printed on the face of the U.S. 5,609,938 parent patent in order that they may be printed on the face of the instant reissue patent, if the instant application is allowed, as required by current reissue practice.

5. Claims 1-21 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. U.S.*, 221 USPQ 289,295 (Fed. Cir. 1984): "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application".

The examiner has carefully examined the prosecution of the parent case. The limitation of a vision panel with a liner attached with a pressure sensitive adhesive means and the limitation of a non perforated backing layer were both added by applicant late in the prosecution of the parent case to overcome the applied art rejection. Also all claims were specifically limited to having the reflective coating and opaque coating on the same side of the transparent panel, opposite the adhesive

Art Unit: 1772

layer, as this was the only configuration supported by Figures 6A and 6C which were in turn the only embodiment that supported a nonperforated backing layer behind a perforated protective liner. All of the claims do not recite a pressure sensitive adhesive means, while claims 15-21 do not recite a non perforated backing layer and have the reflective and opaque coatings on different sides of the transparent panel. The absence of these limitations in the instant claims causes the instant claims to be either broader or at least as broad, regarding limitations material to overcoming the prior art rejections in the parent case, as the claims in the parent U.S. 5,609,938 patent. The instant claims thus involve recapture and are improper.

6. Claims 2-3, 8 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original instant specification as filed in the 08/324,889 application does not support the mirror limitations of claims 2 and 3. Claim 2 requires the mirror to be between the release liner and nonperforated backing layer while claim 3

Art Unit: 1772

requires the nonperforated backing layer to be a mirror. The specification, as filed, in Figure 10 only shows the mirror between an opaque layer element 24 and the release layer element 50. Page 22, line 25 through page 26, line 4 of the '899 spec (col. 10, lines 5-10 of the patent) allow the use of the mirror in other embodiments but do not specify the specifics of the mirror location and mirror perforation of claims 2 and 3. Regarding claim 8, col. 6, lines 44-45 of the patent do not support this claim. The lines refer to a clear adhesive. Light transmitting materials do not absorb light as required by the claim. Regarding claims 18-21, they call for the light-absorbing layer to function as a screen and provide a 3D effect via lens or holograms. The patent at col. 4, lines 25-30 calls for the reflective layer not the absorbing layer to function as a screen. The patent at col. 4, lines 49-52 requires the reflective image layer to have the lens and hologram effects not the light absorbing layer.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

Art Unit: 1772

art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Hill (U.S. 4,673,609) in view of Frey (U.S. 1,199,882) further in view of Mallik (U.S. 5,128,779) and Rosenthal (U.S. 4,034,555).

Hill teaches the basic concept of a panel which has an image that can be seen from the first side without an observer on the first side seeing the second side, with an observer on the second side being able to see through the panel to the first side (Figure 26(2), column 20, lines 30-35). The image may be reflective with an opaque layer on an opposite side (column 6, lines 55 through col. 7, line 10). The panel may screen U.V. light (column 3, line 1). The vision effects of the panel may be formed by use of a perforated panel with the perforations allowing sight through the panel and the non-perforated areas blocking vision, with a reflective image pattern on one side of the panel with the perforations (column 13, lines 37-49, claim 15 (reexam certificate issued July 25, 1995, attached to the back of the main reference)). The panel may have an attachment adhesive and a protective release layer (claim 15, reexam cert.). The perforated sheet (silhouette pattern) and image may be between transparent protective cover sheets (column 14, lines 1-10). The sheet with the silhouette pattern may be attached to a static

Art Unit: 1772

cling film (which maybe colored or transparent), or may be a static cling film (column 14, lines 30-40, lines 50-65). The panel may have a mirror layer (col. 14, line 65 through col. 15, line 10). Multiple panels may be used to form the reflective and opaque layers (col. 14, lines 5-15). Frey teaches in Figure 2 the use of a staggered pattern of transparent areas in a panel which functions as a silhouette pattern that allows viewing from one side through the panel and a reflected image from the other side. Mallik teaches the use of a discontinuous hologram that is formed with many openings that allows a three dimensional image to be seen from some angles in front of the hologram and vision through the hologram (abstract, col. 11 lines 28-30, col. 4, lines 45-60, col. 9, lines 15-30, col. 11, lines 10-20). Rosenthal teaches the use of a lenticular lens layer over an image in order to form a three dimensional image. The instant invention claims the use of a perforated opaque sheet with an image on one side that has staggered holes. The instant invention further claims use of a hologram and lenticular lenses to form a three dimensional image. It would have been obvious to one of ordinary skill in the art to use transparent areas or holes in the panel of Hill in a staggered pattern because Frey teaches this pattern as a design choice for transparent areas in a viewing panel with the function of the Hill panel. A staggered pattern in the flexible embodiments of Hill would inherently give



Art Unit: 1772

tearing resistance. The Frey pattern is presumed to have the open area % of the instant claims since it allows enough light through the panel to allow viewing through the panel from the back side as does the pattern of the instant claims. Variation in the number and position of protective and mounting layers would have been obvious to one of ordinary skill in the art given the teachings of Hill. It further would have been obvious to enhance the image of Hill in view of Frey by the use of a perforated hologram to provide a three dimensional effect for the image layer because of the teachings of Mallik. It further would have been obvious to use a lenticular lens system as an alternative to a hologram in order to form a three dimensional effect because of the teachings of Rosenthal.

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (U.S. 4,673,609) in view of Frey (U.S. 1,199,882) further in view of Mallik (U.S. 5,128,779) and Rosenthal (U.S. 4,034,555) as applied to claims 15-21 above, and further in view of Bogner (DE 28 38 028).

Hill as modified above teaches perforated image, adhesive and liner layers which may be flexible and further printed after perforation (col. 13, 30-35, 40-45). Bogner teaches applying a nonperforated backing layer to permeable fabric layer in order to allow the fabric layer to be better handled by various printing

Art Unit: 1772

machines. The instant invention claims the use of a perforated image and liner layer with a nonperforated backing. It would have been obvious to one of ordinary skill in the art to use a nonperforated backing layer on the perforated image and liner layers of Hill as modified above in order to allow handling of the perforated combination during further printing because of the teachings of Bogner.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Akers (GB 2 244 585 A) teaches a perforated transparent panel with printed layers to allow image and through panel vision. WO 95/19268 teaches a perforated vision panel with a solid backing layer for printing. This reference is not prior art to the instant application. Shields (U.S. 5,773,110) disclaims the term after the expiration of the instant parent patent. Hill et al. (U.S. 5,858,155) though not prior art to the instant patent states in col. 1, lines 50-60 that a nonperforated backing layer over a perforated release layer was believed to be on sale no later than September 1993. Such a sale if proven with adequate evidence could anticipate or render obvious the instant claims. The statement in the Hill et al. patent is not supported by mention of specific facts supplied under oath and cannot serve as evidence against the instant claims.

Art Unit: 1772

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is (703) 308-2420.

The examiner's normal work hours are Monday through Friday 9:30 A.M. through 6:00 P.M. The examiner's supervisor is Ellis Robinson whose telephone number is (703) 308-2364. Any general inquiry can be directed to the Group receptionist whose telephone number is (703) 308-0651.

The Fax number for official **after final** papers is 703-305-3599. The Fax number for official **non-final** papers is 703-305-5408. The Fax number for **informal** non-official communications directed to the examiner is 703-305-5436.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ellis.robinson@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.



WILLIAM P. WATKINS III  
PRIMARY EXAMINER

WW/ww  
August 11, 1999